

/Aaron Greso/

ENTER IN PART: /A.G./

06/29/2011

Attorney File Ref: 102790-128 / 30044

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Felix FLACHSMANN, et al.
Serial No.: 10/552655
Filed: 11.Oct.2005
Examiner: Aaron J. GRESO
Art Group: 1796
Title: CARBAMATES USEFUL AS FRAGRANCES

Per EFS

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313 -- 1450

26.Jun.2011

Dear Sir,

AMENDMENT AFTER FINAL REJECTION

This paper is responsive to the *Office Action (Final Rejection)* dated 27.Apr.2011 in the above identified application.

As this paper is being filed within 2 months of the issue of the *Office Action*, early and favorable consideration of this response is requested.

Kindly enter the following amendments to the application and consider the following remarks.

/Aaron Greso/

ENTER IN PART: /A.G./

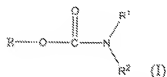
06/29/2011

In the Claims:

1.(cancelled)

2.(cancelled)

- 3.(previously presented) A method of manufacturing a fragrance application, comprising the incorporation as fragrance ingredient of a tertiary non-vinylc carbamate of formula (I)



wherein

R¹ and R² are independently selected from the group consisting of:

- (a) C₁ to C₁₁ alkyl; C₃ to C₁₁ alk-(>1)-enyl; or C₂ to C₁₁ alkynyl group; and
- (b) cycloalkyl optionally substituted with alkyl, alkenyl and alkoxy group(s); C₃ to C₈ cycloalkenyl optionally substituted with alkyl, alkenyl and alkoxy group(s); or phenyl or naphthyl optionally substituted with alkyl, alkenyl and alkoxy group(s); and
- (c) C₄ to C₁₄ cycloalkylalkyl, wherein the cycloalkyl ring is optionally substituted with alkyl, alkenyl and alkoxy group(s); or phenylalkyl or naphthylalkyl, wherein the aromatic ring is optionally substituted with alkyl, alkenyl and alkoxy group(s); and

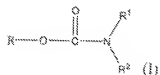
R is selected from the group consisting of:

- (a) C₁ to C₁₁ alkyl; C₃ to C₁₁ alk-(>1)-enyl; or C₂ to C₁₁ alkynyl group; and
- (b) cycloalkyl optionally substituted with alkyl, and alkenyl group(s); C₃ to C₈ cycloalkenyl optionally substituted with alkyl, and alkenyl group(s); or phenyl or naphthyl optionally substituted with alkyl, and alkenyl group(s); and

- (c) C₄ to C₁₄ cycloalkylalkyl, wherein the cycloalkyl ring is optionally substituted with alkyl, and alkenyl group(s); C₄ to C₁₄ cycloalkenylalkyl, wherein the cycloalkenyl ring is optionally substituted with alkyl, and alkenyl group(s); or phenylalkyl or naphthylalkyl, wherein the aromatic ring is optionally substituted with alkyl, and alkenyl group(s); and
- (d) heteroaromatic ring optionally substituted with alkyl, alkenyl and alkoxy group(s); heteroarylalkyl ring optionally substituted with alkyl, alkenyl and alkoxy group(s); heterocyclic ring optionally substituted with alkyl, alkenyl and alkoxy group(s) or heterocycloalkyl ring optionally substituted with alkyl, alkenyl and alkoxy group(s); and the ring having 5 to 6 ring members and the hetero atom of the ring is oxygen or nitrogen; and
- R, R¹ and R² having together 7 to 18 carbon atoms, and further wherein the fragrance ingredient is a fragrance.

4.(cancelled)

5.(previously presented) A compound of formula (I)



wherein the compound is a fragrance, and further wherein the groups R, R¹ and R² are selected according to the following table:

R	R ¹	R ²
hex-3-enyl	ethyl	ethyl
2-ethyl-hexyl	methyl	methyl
methyl	ethyl	methyl-tolyl
methyl	ethyl	ethyl-tolyl
3-methyl-but-2-enyl	ethyl	ethyl
3-methyl-but-3-enyl	ethyl	ethyl

hex-3-enyl	methyl	iso-propyl
2,2,5-trimethyl-hex-4-enyl	ethyl	ethyl
undec-10-enyl	methyl	methyl
2-ethyl-hexyl	methyl	iso-propyl
2-ethyl-hexyl	ethyl	iso-propyl
1,1-dimethyl-(4-methyl-cyclohex-3-enyl)-ethyl	methyl	methyl
1,1-dimethyl-(4-methyl-cyclohex-3-enyl)-methyl	methyl	methyl
ethyl	methyl	hexyl
2-methyl-propyl	methyl	butyl
2-methyl-propyl	ethyl	butyl
1,2-dimethyl-1-propyl-propyl	methyl	methyl
1,2-dimethyl-1-propyl-iso-propyl	methyl	methyl
furylmethyl	ethyl	ethyl

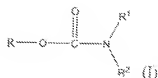
6.(cancelled)

7.(cancelled)

8.(previously presented) A method of manufacturing a fragrance application according to claim 3, wherein the fragrance application is selected from the group consisting of perfume, household product, laundry product, body care product and cosmetics.

9.(cancelled)

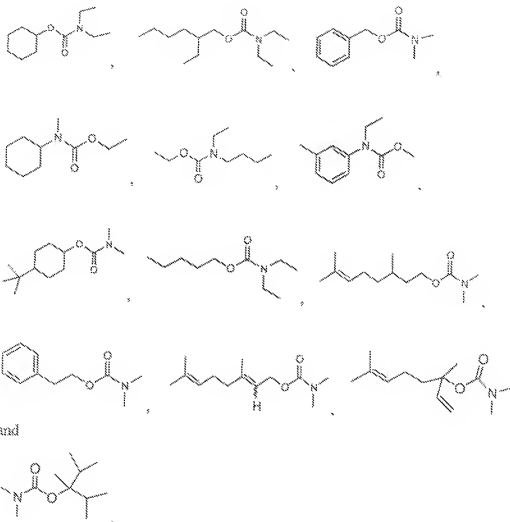
10.(previously presented) A method of manufacturing a fragrance application according to claim 3, wherein the fragrance ingredient is a compound selected from a compound according to formula (i)



wherein the groups R, R¹ and R² are selected according to the following table:

R	R ¹	R ²
hex-3-enyl	ethyl	ethyl
2-ethyl-hexyl	methyl	methyl
methyl	ethyl	methyl-tolyl
methyl	ethyl	ethyl-tolyl
3-methyl-but-2-enyl	ethyl	ethyl
3-methyl-but-3-enyl	ethyl	ethyl
hex-3-enyl	methyl	iso-propyl
2,2,5-trimethyl-hex-4-enyl	ethyl	ethyl
undec-10-enyl	methyl	methyl
2-ethyl-hexyl	methyl	iso-propyl
2-ethyl-hexyl	ethyl	iso-propyl
1,1-dimethyl-(4-methyl-cyclohex-3-enyl)-ethyl	methyl	methyl
1,1-dimethyl-(4-methyl-cyclohex-3-enyl)-methyl	methyl	methyl
ethyl	methyl	hexyl
2-methyl-propyl	methyl	butyl
2-methyl-propyl	ethyl	butyl
1,2-dimethyl-1-propyl-propyl	methyl	methyl
1,2-dimethyl-1-propyl-iso-propyl	methyl	methyl
isobutylmethyl	ethyl	ethyl

11. (previously presented) A method of manufacturing a fragrance application according to claim 3, wherein the fragrance ingredient is a compound selected from the group consisting of



and

12.(canceled)

13.(previously presented) A method of manufacturing a fragrance application according to claim 11, herein the fragrance application is selected from the group consisting of perfume, household product, laundry product, body care product and cosmetics.

14.(cancelled)

15.(previously presented) A method of manufacturing a fragrance application according to claim 10, wherein the fragrance application is selected from the group consisting of perfume, household product, laundry product, body care product and cosmetics.

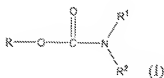
16.(cancelled)

17.(cancelled)

18.(previously presented) A method of manufacturing a fragrance application, comprising the incorporation as fragrance ingredient of a compound of formula (I) according to claim 5.

19.(previously presented) A method of claim 18 wherein the fragrance application is selected from the group consisting of perfume, household product, laundry product, body care product and cosmetics.

20.(new) A method of manufacturing a fragrance application, comprising the incorporation as fragrance ingredient of a tertiary non-vinylc carbamate of formula (I)



wherein

$\text{R}^1 = \text{R}^2$ and which are selected from the group consisting of:

- (d) C_1 to C_{11} alkyl; C_3 to C_{11} alk-(>1)-enyl; or C_2 to C_{11} alkynyl group; and
- (e) cycloalkyl optionally substituted with alkyl, alkenyl and alkoxy group(s); C_3 to C_8 cycloalkenyl optionally substituted with alkyl, alkenyl and alkoxy group(s); or phenyl or naphthyl optionally substituted with alkyl, alkenyl and alkoxy group(s); and

- (f) C₄ to C₁₄ cycloalkylalkyl, wherein the cycloalkyl ring is optionally substituted with alkyl, alkenyl and alkoxy group(s); or phenylalkyl or naphthylalkyl, wherein the aromatic ring is optionally substituted with alkyl, alkenyl and alkoxy group(s); and

R is selected from the group consisting of:

- (d) C₁ to C₁₁ alkyl; C₃ to C₁₁ alk-(>1)-enyl; or C₂ to C₁₁ alkynyl group; and
(e) cycloalkyl optionally substituted with alkyl, and alkenyl group(s); C₃ to C₈ cycloalkenyl optionally substituted with alkyl, and alkenyl group(s); or phenyl or naphthyl optionally substituted with alkyl, and alkenyl group(s); and
(f) C₄ to C₁₄ cycloalkylalkyl, wherein the cycloalkyl ring is optionally substituted with alkyl, and alkenyl group(s); C₄ to C₁₄ cycloalkenylalkyl, wherein the cycloalkenyl ring is optionally substituted with alkyl, and alkenyl group(s); or phenylalkyl or naphthylalkyl, wherein the aromatic ring is optionally substituted with alkyl, and alkenyl group(s); and
(d) heteroaromatic ring optionally substituted with alkyl, alkenyl and alkoxy group(s); heteroarylalkyl ring optionally substituted with alkyl, alkenyl and alkoxy group(s); heterocyclic ring optionally substituted with alkyl, alkenyl and alkoxy group(s) or heterocycloalkyl ring optionally substituted with alkyl, alkenyl and alkoxy group(s); and the ring having 5 to 6 ring members and the hetero atom of the ring is oxygen or nitrogen; and
R, R¹ and R² having together 7 to 18 carbon atoms, and
further wherein the fragrance ingredient is a fragrance.

Remarks:

Amendments to the claims:

Claims 3, 5, 8, 10, 11, 13, 15, 18 and 19 are pending in this application, and new claim 20 has been entered, which new claim is believed to overcome the Examiner's grounds of rejection. Full consideration of this claim, and entry of this claim, is solicited. Support for the claim is found at para. [0027] of applicant's published patent specification, US 2006/0270588.

Regarding the rejection of claim 3 under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being obvious over US 2060733 to Karr Hunt et al. (hereinafter "Karr Hunt"); and the rejection of claim 5 under USC 103(a) as allegedly being obvious over Karr Hunt:

Applicants respectfully traverse the rejections of the foregoing claims in view of Karr Hunt.

The Patent Office alleges that Karr Hunt teaches or suggests each and every feature of claim 3. Additionally, the Patent Office alleges that each and every feature of claim 5 would have been obvious to a skilled artisan at the time of the invention in view of Karr Hunt. The applicant also asserts that newly presented claim 20 would not be anticipated or could be considered obvious in view of the Karr Hunt reference. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Claim 3 requires a method of manufacturing a fragrance application, comprising the incorporation as fragrance ingredient of a tertiary non-vinylc carbamate of formula (I), wherein the fragrance ingredient is a fragrance.

Claim 5 requires a compound of formula (I) wherein the compound is a fragrance.

Newly presented claim 20, --- a substantially narrowed amended claim 3 --- requires a method of manufacturing a fragrance application, comprising the incorporation as fragrance ingredient of a tertiary non-vinylc carbamate of formula (I), wherein the fragrance ingredient is a fragrance, and wherein $R_1 = R_2$.

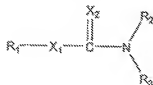
Karr Hunt does not teach or suggest the presently claimed method of manufacturing a fragrance application as recited in claim 3 because Karr Hunt discloses agents for the deterioration of cellulosic substances as he recites in the following excerpt from col. 1:

This invention relates to the art of retarding deterioration of organic materials and more particularly to the stabilizing of cellulose, cellulose manufactures, and chemical derivatives of cellulose.

It has been discovered that deterioration of the above materials can be effectively retarded by treating them with small amounts of certain stabilizing chemical agents, namely, esters and N-substituted esters of carbamic, thiocarbamic, thiolcarbamic, and dithiocarbamic acids.

A particular object of this invention is to provide methods of decreasing the deterioration, due to or initiated by ultraviolet rays and other causes, of those cellulosic substances included in the group consisting of regenerated cellulose, cellulose ethers, and organic acid esters of cellulose.

Karr Hunt's formulae conform to the following general formula



wherein $X_1, X_2 = O, S$ or

= hydrocarbon residue

$R_2, R_3 = H$, organic (especially hydrocarbon) radicals.

R₁, R₂, and R₃, for example, may be such general types of hydrocarbon radicals as alkyl, alkenyl, aryl, aralkyl, cycloalkyl, etc.

or such particular hydrocarbon radicals as methyl, ethyl, propyl, i-butyl, amyl, decyl, dodecyl, octadecyl, phenyl, tolyl, xylyl, naphthyl, benzyl, cinnamyl, 9,10-octadecenyl, cyclohexyl, naphthenyl, etc. (See page 1, col. 1, lines 1-5 and col. 2, lines 32-50).

The present claims are directed a subgenus of tertiary carbamates possessing an odor which makes the tertiary carbamates suitable as fragrance ingredients. Karr Hunt, at best, discloses only one single tertiary carbamate, namely, N-methyl-N-phenyl ethyl carbamate out of 27 other types carbamates: Karr Hunt only discloses the utility of his compounds as stabilizers for cellulose manufactures.

Nowhere does Karr Hunt teach or suggest a method of manufacturing a fragrance application comprising the incorporation as fragrance ingredient of a tertiary non-vinylc carbamate of formula (I), wherein the fragrance composition is a fragrance as recited in claim 3, and even less so wherein the fragrance composition is a fragrance as recited in claim 20 presented herein. Further, Karr Hunt fails to teach or suggest a compound of formula (I) wherein the compound is a fragrance as recited in claim 5. Thus, from the foregoing passage at of Karr Hunt, it is quite clear that Karr Hunt's compounds are identified as useful *only* stabilizers to prevent the deterioration of cellulose manufactures.

It is the applicant's position that due to the fact that Karr Hunt is *solely* directed to specific identified compounds as cellulose stabilizing agents, that, such is *nonanalogous* prior art to the technical problem facing the current inventors, namely that of providing a fragrance. No skilled artisan faced with this technical problem would look to or consider Karr Hunt's stabilizers when considering fragrancing compounds. The Examiner is reminded that as cited in *In re Klein* No. 3010-1411, slip Opinion, at 7 (Fed. Cir. 2011) that "A reference qualifies as prior art for an obviousness determination under §103 only when it is analogous to the claimed invention. *Innovation Toys, LLC v. MGA*

Entertainment, Inc. No. 1210-1290, slip. Op. at 12 (Fed. Cir. Mar. 21, 2011); *In re Bigio*, 381 F.3rd 1320, 1325 (Fed.Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir., 1992). “Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem to be addressed and, (2) if the reference is not in the field of the inventor’s endeavor, whether the reference [is] still reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, at 1325. “ The Court also recognized in *In re Klein*, slip Opinion, at 12, by citing in *In re Clay*, 966 F.2d at 659 that “If [a reference] is directed to a different purpose, the inventor would have had less motivation or occasion to consider it.” It is the applicant’s position that neither of the tests (1) and (2) of *In re Bigio* are met by the Karr Hunt reference, and due to the disparity between stabilizers for cellulose manufacturers and fragrancng comopunds, that a skilled artisan concerned with producing a fragrancng compound would *not* consider Karr Hunt’s pharmaceutically active compounds as candidates for use in a fragrancng method as per claims 3 and 30, or as fragrancng materials as per claim 5 as presented herein.. Accordingly it is the applicant’s view that pursuant to the recent decision of *In re Klein*, No. 3010-1411, slip Opinion (Fed. Cir. 2011) that the Examiner’s reliance upon Karr Hunt is inappropriate and that reference should be dismissed from any consideration, and that the current grounds of rejection should be withdrawn.

Additionally, and in the alternative, the Examiner’s reliance upon Karr Hunt is improper as being an impermissible “hindsight reconstruction” of the applicant’s claimed invention. The Examiner is reminded that it is well settled law that is impermissible to “pick-and-choose” amongst a prior art reference’s purported teaching, whether considered alone or in combination with other references, in order to use the benefit of hindsight in order to arrive at a claim the invention. See *Ex Parte Kranz* 19 USPQ2d 1216 (PTO Bd. 1991); *In re Kerkhoven* 205 USPQ 1069 (CCPA, 1980); *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1983) The presently claimed invention is not all perceivable from the Karr Hunt reference.

Because the features of independent claims 3, 5 and 20 are not disclosed, taught or suggested by Karr Hunt, Karr Hunt cannot anticipate, nor would not have rendered obvious, the features specifically defined in claims 3, 5 and 20. Accordingly, reconsideration of and withdrawal of the rejections of the claims under 35 USC 102(b)/103(a) and 103(a) are respectfully requested.

Regarding the rejection of claims 3, 5, 8, 10, 11, 13, 15, 18 and 19 under 35 USC 103(a) as allegedly being unpatentable over US Patent Publication No. 2001/0036907 to Finch et al. (hereinafter "Finch") in view of Karr Hunt:

Applicants respectfully traverse the rejection of the foregoing claims in view of the combined Finch and Karr Hunt references.

The Patent Office alleges that each and every feature of the foregoing claims would have been obvious to a skilled artisan at the time of the invention in view of the combined teachings of Finch and Karr Hunt. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Finch describes his invention as follows:

DEFINITION OF THE INVENTION

[0016] Thus, a first aspect of the present invention now provides a method of improving perfume deposition onto fabrics in a laundry treatment process and/or retention of perfume on laundered fabrics, comprising using a laundry treatment composition comprising a water-soluble or water-dispersible rebuild agent for deposition onto a fabric during the laundry treatment process wherein the rebuild agent undergoes during the laundry treatment process, a chemical change by which change the affinity of the rebuild agent for the fabric is increased, said chemical change resulting in the loss or modification of one or more groups covalently bonded to be pendant to a polymeric backbone of the rebuild agent via an ester linkage, the ester-linked group(s) being selected from monocarboxylic acid esters.

As is seen from the forgoing, Finch's "rebuild agent" is a material which undergoes a "chemical change, by which change the affinity of the rebuild agent for the fabric is increased, said chemical change resulting in the loss or modification of one or more groups covalently bonded to be pendant to a polymeric backbone of the rebuild agent via an ester linkage..." Relevantly, Finch *separately* defines a "perfume" as a material which is *not* his "rebuild agent". Such appears to be acknowledged at page 6 of the Office Action as well wherein the Examiner states:

The reference does not further teach the employment of carbamate materials within the Claim 3, 5, 10, and for those of the Applicants' instant Claim 11 genus of materials comprised in the fragancing compositions.

On the other hand, Karr Hunt et al. discloses a genus of carbamate materials [see Figure 1 above] that are indicated to prevent the deterioration of esterified cellulose materials (ent 2-3 lines 33-50 and 1-6 respectively). The carbamates is applied to fabric material in water (pages 2-3 Examples 2-3) and are indicated to be used in a process of adding the carbamate materials to cellulose materials (page 3 claims 1-2).

Applicants agree with the Patent Office that Finch fails to teach or suggest the presently claimed carbamates. However, as discussed above with respect to the rejection that solely based on Karr Hunt, Applicants submit that Karr Hunt fails to remedy the deficiencies of Finch with respect to independent claims 3, 5 as well as with respect to claim 20. A skilled artisan, would note that nowhere does Finch teach the use of carbamate materials in fragancing compositions. The skilled artisan would note that Finch's "rebuilding agents" are reactive compounds which undergo a chemical change to improve their affinity for fibrous compounds. There is no motivation for a skilled artisan, seeking to provide either a method for manufacturing a fragancing application (see applicant's claims 3, 20) or to provide a fragancing compound (see applicant's claim 5)

would consider either of Finch or Karr Hunt to be relevant. See *In re Klein* No. 3010-1411, slip Opinion, at 7 (Fed. Cir. 2011) that “A reference qualifies as prior art for an obviousness determination under §103 only when it is analogous to the claimed invention. *Innovention Toys, LLC v. MGA Entertainment, Inc.* No. 1210-1290, slip. Op. at 12 (Fed. Cir. Mar. 21, 2011); *In re Bigio*, 381 F.3^d 1320, 1325 (Fed.Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir., 1992).

The applicant traverses the Examiner’s assertion at page 7 of the Office Action wherein is stated:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have added a cellulose preserving material with inherent fragrance properties successfully employed with fabrics as taught by Karr Hunt et al., to a fragrance retention enhancing compositions employed with cellulose materials in laundry applications, as taught by Finch et al., that are also suggested by Finch et al. as being desired to provide fragrance material for as long as possible, with a reasonable expectation of success.

Finch does not teach carbamates having any fragrancing benefit, but rather only teaches the use of his “rebuild agent” which is *not* a perfume. Karr Hunt also teaches nothing regarding any perfuming or fragrancing benefit, and thus a skilled artisan seeking an improved method of providing a fragrance, or a fragrancing compound would *not* consider either Finch or Karr Hunt singly or jointly. *In re Klein*, slip Opinion, at 12, citing in *In re Clay*, 966 F.2d at 659 that “If [a reference] is directed to a different purpose, the inventor would have had less motivation or occasion to consider it.” A skilled artisan considering the Finch and Karr Hunt references with an intent to find improved fragrance compounds or methods of producing an improved fragranced application, would *not* have been motivated by either of those teachings to modify Finch’s laundry treatment composition with Karr Hunt’s cellulosic deterioration substavees.

The Examiner is reminded that it is well settled law that is impermissible to "pick-and-choose" amongst a prior art reference's purported teaching, whether considered alone or in combination with other references, in order to use the benefit of hindsight in order to arrive at a claim the invention. See *Ex Parte Kranz* 19 USPQ2d 1216 (PTO Bd, 1991); *In re Kerkhoven* 205 USPQ 1069 (CCPA, 1980); *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1983) The presently claimed invention is not all perceivable from the Finch and Karr Hunt reference for the reasons noted above.

Because the features of independent claims 3, 5 and 20 are not disclosed, taught or suggested by the Finch and Karr Hunts, the references cannot have rendered obvious, the features specifically defined in claims 3, 5 and 20. Similarly the Examiner's rejection of claim 11, a claim depending from claim 3, cannot stand. Accordingly, reconsideration of and withdrawal of the rejections of the indicated claims under 35 USC 103(a) are respectfully requested.

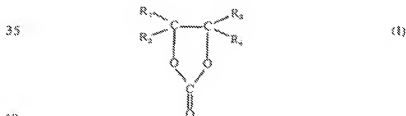
Regarding the rejection of claims 3 and 8 under 35 USC 103(a) as allegedly being unpatentable over US Patent No. 3,966,903 to Torii et al. (hereinafter "Torii") in view of US Patent No. 4,260,526 to Kaiser et al. (hereinafter "Kaiser"):

Applicants respectfully traverse the rejection of the foregoing claims in view of Torii and Kaiser.

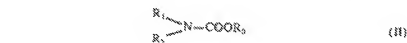
The Patent Office alleges that each and every feature of claims 3 and 8 would have been obvious to a skilled artisan at the time of the invention in view of the teachings of Torii and Kaiser. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Torii discloses hair-waving compositions, as he recites:

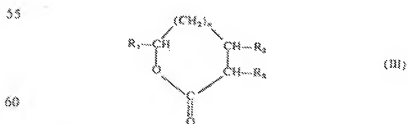
In accordance with this invention, there is provided a hair-waving composition which comprises (A) at least one main waving agent selected from sulfites and bisulfites and (B) at least one wave accelerating agent selected from alkylene carbonates of the general formula:



wherein R_1 , R_2 , R_3 and R_4 each stand independently for hydrogen atom, methyl group, ethyl group, hydroxyethyl group or hydroxymethyl group, alkyl carbamates of the general formula:



50 wherein R_1 , R_2 and R_3 each stand independently for hydrogen atom, methyl group, ethyl group or propyl group, and γ - or δ -lactones of the general formula:



wherein R_1 , R_2 and R_3 each stand for hydrogen atom or methyl group, and n for an integer of 0 to 1.

According to the above-identified definition, 64 ($4 \times 4 \times 4$) carbamates are disclosed, three of these 64 carbamates are given as an example, namely methyl carbamate, ethyl carbamate and ethyl N,N-dimethylcarbamate (see col. 3, lines 24 - 26). Only one

carbamate, namely, ethyl carbamate was explicit used. However, ethyl carbamate does not disclose a compound of formula (I) as recited in claim 3. Rather, the only exemplified tertiary carbamate is ethyl N,N-dimethylcarbamate ($R^1 = R^2 = \text{methyl (1 C atom)}$; $R = \text{ethyl (2 C atoms)}$, thus $R^1 + R^2 + R = 4 \text{ C atoms}$); however, this compound also fails to disclose a compound of formula (I).

The applicants note the Examiner's first characterization at page 8 of the Office Action:

In Figure 3, R_1 , R_2 , and R_3 are chosen from a group comprising, methyl, ethyl, and propyl groups. The formulations are not are not indicated to have an unpleasant odor (Abstract) when adding this material (col 3 lines 32-45).

The applicant's traverse the Examiner's following characterization also at page 8 of the Office Action:

These genus attributes satisfy the instant Claim 3 genus and can be readily envisaged when R_1 , R_2 , and R_3 of the reference are each C_1 - C_{11} alkyl groups for the Claim 3 genus group a) for each R , R^1 and R^2 species comprise at least two propyl groups or at least one ethyl or methyl in combination with two propyl moieties.

Because the Applicants indicate that the materials are fragrant, it is taken that the materials are also added as fragrances or as fragrant materials without an unpleasant odor as the materials are within the genus of the Applicants. Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

As well as the following passage from page 9 of the Office Action:

All chemicals in the genus of Figure 2 are indicated to possess no unpleasant odors (col 3 lines 32-34), while the materials are not indicated to be odorless.

The foregoing passages appear to be sourced from the following passage of the Torii specification:

“All of these compounds possess no unpleasant odor and high safety in hygiene and are used either alone or in combination of at least two of them. When these compounds are applied together with the main waving agent to hair, they introduce the main agent safely and effectively into the hair cuticle and allow the main ingredient to penetrate into the hair keratin, whereby the waving effect achieved by the main agent is greatly enhanced.”

35
40

It appears that the Examiner improperly relies upon Torii's statement of “no unpleasant odor” as necessarily reciting that the compounds of Torii would have a fragrance, although this is not specified by Torii. Torii's statement may equally likely be interpreted as stating that Torii's compounds may be *odorless* and thus would also have “no unpleasant odor”. The applicants respectfully disagree with the Examiner's interpretation that such disclosure indicates that the Torii's compounds are intended to be used as a fragrance ingredient because Torii's compounds have “no unpleasant odor”. Instead, the applicant asserts that Torii's compounds are used because they accelerate the waving process because Torii's compounds are accelerating agents which act upon hair and to provide a function which is not directed to providing a fragranting benefit. From Applicants' point of view, Torii, at best, only mentions that Torii's compounds do not possess unpleasant odor because the prior art waving compositions do possess an unpleasant odor (see col. 1, lines 40 – 42). There is nothing in Torii which explicit or inherently teaches that tertiary alkyl carbamates possess a pleasant odor. See *In re Klein* No. 3010-1411, slip Opinion, at 7 (Fed. Cir. 2011) that “A reference qualifies as prior art for an obviousness determination under §103 only when it is analogous to the claimed

invention. *Innovation Toys, LLC v. MGA Entertainment, Inc.* No. 1210-1290, slip. Op. at 12 (Fed. Cir. Mar. 21, 2011); *In re Bigio*, 381 F.3rd 1320, 1325 (Fed.Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir., 1992). Nowhere does Torii disclose that the accelerating agents could be combined with other material including perfumes. At best, Torii only mentions that Torii's compositions, namely a hair-waving compositions comprising (A) sulfites or bisulfites as the primary waving agent and (B) at least one wave accelerating agent, may be combined (see col. 4, lines 46--52).

Torii does not teach a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance. Kaiser fails to remedy the deficiencies of Torii because Kaiser also fails to teach a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance. The Examiner's attention is directed to claims 3, 5 and 20 as presented in this paper.

Regarding the combination of Torii with Kaiser, Applicants submit that the Patent Office's generalization of Kaiser's gamma-valerolactone is not admissible. Gamma-valerolactone belongs to a completely different class of molecules, namely lactones of Kaiser's general formula (III). See *In re Klein* No. 3010-1411, slip Opinion, at 7 (Fed. Cir. 2011) that "A reference qualifies as prior art for an obviousness determination under §103 only when it is analogous to the claimed invention. *Innovation Toys, LLC v. MGA Entertainment, Inc.* No. 1210-1290, slip. Op. at 12 (Fed. Cir. Mar. 21, 2011); *In re Bigio*, 381 F.3rd 1320, 1325 (Fed.Cir. 2004); *In re Clay*, 966 F.2d 656, 658 (Fed. Cir., 1992). The Examiner is again reminded that it is well settled law that is impermissible to "pick-and-choose" amongst a prior art reference's purported teaching, whether considered alone or in combination with other references, in order to use the benefit of hindsight in order to arrive at a claim the invention. See *Ex Parte Kranz* 19 USPQ2d 1216 (PTO Bd, 1991); *In re Kerkhoven* 205 USPQ 1069 (CCPA, 1980); *W.L. Gore & Associates, Inc. v.*

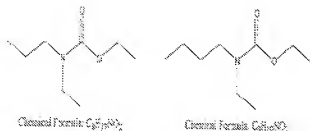
Garlock, Inc. 220 USPQ 303 (CAFC, 1983) The presently claimed invention is not all perceivable from the Torii and Kaiser references for at least the reasons noted above.

Accordingly, Torii and Kaiser, taken singly or in combination, fail to teach or suggest a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyllic carbamate, wherein the fragrance ingredient is a fragrance as required by claim 3, 5 or claim 20 as presented herein. For similar reasons, the rejections lodged against claim 8, a claim which depends on claim 3 which claim is properly considered allowable over the prior art, should also be withdrawn. Accordingly, reconsideration of and withdrawal of the rejection of the indicated rejected claims under 35 USC 103(a) are respectfully requested.

Regarding the rejection of claims 11 and 13 under 35 USC 103(a) as allegedly being unpatentable over Torii.

Applicants respectfully traverse the rejection of the foregoing claim in view of Torii.

The Patent Office alleges that each and every feature of claims 11 and 13, which depend from claim 3, would have been obvious to a skilled artisan at the time of the invention in view of the teachings of Torii. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.



Applicants submit that the above-identified compound (R= ethyl; R¹= ethyl, R²= butyl, 5th compound) may be regarded as a homolog or structural isomer of the genus as defined by

Torii. However, Applicants submit that this is only relevant with respect to properties which are expected to be similar. Further, as discussed above, Torii does not clearly teach that Torii's compounds exhibit an odor nor would a skilled artisan expect Torii's compounds to exhibit an odor.

Additionally the in the following excerpt from page 11 of the Office Action the Examiner admits that Torii fails to disclose the compounds of claim 11 and 13:

Further as to Claims 11, 13:

The reference does not further disclose employing chemicals in the Claim 11 genus.

In view of the foregoing then, the compounds of claims 11 and 13 are not explicitly disclosed in Torii and is, at best, only construed by the Patent Office. Further in view of the foregoing, the Examiner's further assertions regarding the physical properties of the compounds of claims 11 and 13 are thus founded, in no small part, on speculations concerning on the further speculation which is derived from Torii's statement of "no unpleasant odor" as necessarily reciting that the compounds of Torii would have a fragrance, although this is not specified by Torii. Torii's statement may equally likely be interpreted as stating that Torii's compounds may be odorless and thus would also have "no unpleasant odor", and is thus speculative in its own right. The applicants respectfully disagree with the Examiner's interpretation that such disclosure necessarily indicates that the Torii's compounds are intended to be used as a fragrance ingredient because Torii's compounds have "no unpleasant odor". Instead, the applicant asserts that Torii's compounds are used because they accelerate the waving process because Torii's compounds are accelerating agents which act upon hair and to provide a function which is not directed to providing a fragrancing benefit.

Torii fails to teach or suggest a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance as required

by claim 3, from which claims 11 and 13 depend. Because the features of independent claim 3 are not taught or suggested by Torii, taken singly or in combination, Torii would not have rendered obvious the features specifically defined in dependent claims 11 and 13. For at least these reasons, claims 11 and 13 are non-obvious in view of Torii. Reconsideration and withdrawal of the rejection of the claims under 35 USC 103(a) are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, including but not limited to extension of time fees, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;



Andrew N. Parfomak, Esq.
Reg. No. 32,431
Norris, McLaughlin & Marcus P.A.
875 Third Avenue
New York, NY 10017

26 June, 2011
Date:

Tel: 212 808-0700